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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/770,459	02/04/2004	Hiroshi Takemoto	248348US-3 DIV	1340
22850	7590	11/13/2006	EXAMINER	
C. IRVIN MCCLELLAND			GOFF II, JOHN L	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.				
1940 DUKE STREET			ART UNIT	
ALEXANDRIA, VA 22314			PAPER NUMBER	
			1733	

DATE MAILED: 11/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/770,459

Applicant(s)

TAKEMOTO ET AL.

Examiner

John L. Goff

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 09/237,661.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to the amendment filed on 8/17/06.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Priority

3. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. [1] as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No. 09/237,661, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. The subject matter of the current and only claim, claim 1, was first introduced at the time of filing Application No. 09/777,847 as new claim 34. Claim 1 requires "curing said first adhesive and said second adhesive such that said intermediate member, but not said first and second members, can move due to shrinkage of at least one of said

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first adhesive and said second adhesive”. This limitation was not disclosed in Application No. 09/237,661, and thus, as the current claim is directed to subject matter other than that disclosed in Application No. 09/237,661 the current claim is not entitled a priority benefit to Application No. 09/237,661. Claim 1 has the benefit of priority only to Application No. 09/777,847 which was filed 02/07/2001. Furthermore, it is noted the declaration submitted 2/4/04 is a copy of that submitted in Application No. 09/237,661, and as this application presents a claim for subject matter not adequately supported or enabled by Application No. 09/237,661 a supplemental oath or declaration is required under 37 CFR 1.67. The new oath or declaration must properly identify the application of which it is to form a part, preferably by application number and filing date in the body of the oath or declaration. See MPEP §§ 602.01 and 602.02.

Specification

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

The specification does not disclose the limitation “curing said first adhesive and said second adhesive such that said intermediate member, but not said first and second members, can move due to shrinkage of at least one of said first adhesive and said second adhesive”. This limitation is not disclosed in the specification such that in order to overcome the objection the specification should be amended to include the limitation or the limitation should be omitted from the claim.

Claim Rejections - 35 USC § 102

5. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Takemoto et al. '784 (U.S. Patent 6,100,784).

Takemoto et al. '784 is available as prior art under 35 U.S.C. 102(b) as the U.S. filing date of claim 1 is 02/07/2001 (the filing date of priority Application No. 09/777,847) as set forth above, and Takemoto et al. '784 published 12/14/99. Takemoto et al. disclose a method of mounting an ink jet printhead comprising providing a first member (14 of Figure 13) and a chuck (24 of Figure 13) for positioning and fixing the first member, providing a second member (11a-d of Figure 13) and a chuck (27 of Figure 13) for positioning and fixing the second member, providing an intermediate member (13a-13d of Figure 13) between the first and second members, applying a first adhesive (15 of Figure 13) at the interface between the first member and the intermediate member, applying a second adhesive (15 of Figure 13) at the interface between the second member and the intermediate member, and curing the first adhesive and the second adhesive such that the intermediate member, but not the first and second members, can move due to shrinkage of the first and second adhesives such that after curing the first member is accurately bonded to the second member through the intermediate member (Figures 11-13 and Column 8, lines 46-67 and Column 9, lines 1-67 and Column 10, lines 1-37). Takemoto et al. '784 also teach another embodiment comprising providing a first member (14 of Figure 25) and a chuck (24 of Figure 25) for positioning and fixing the first member, providing a second member (11d of Figure 25) and a chuck (27 of Figure 25) for positioning and fixing the second member, providing an intermediate member (13a of Figure 25) between the first and second members, applying a first adhesive (15 of Figure 25) at the interface between the first member

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and the intermediate member, applying a second adhesive (15 of Figure 25) at the interface between the second member and the intermediate member, and curing the first adhesive and the second adhesive such that the intermediate member, but not the first and second members, can move due to shrinkage of the first and second adhesives such that after curing the first member is accurately bonded to the second member through the intermediate member (Figure 25 and Column 15, lines 36-62 and Column 16, lines 25-45)

6. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Takemoto et al. '015 (U.S. Patent 6,627,015).

Takemoto et al. '015 is available as prior art under 35 U.S.C. 102(e) as the U.S. filing date of claim 1 is 02/07/2001 (the filing date of priority Application No. 09/777,847) as set forth above, and Takemoto et al. '015 has a U.S. filing date of 3/10/1998. Takemoto et al. '015 discloses the same as Takemoto et al. '784 discussed in full detail above (See Figures 13 and 25 and Column 8, lines 50-67 and Column 9, lines 1-67 and Column 10, lines 1-40 and Column 15, lines 38-64 and Column 16, lines 28-48 of Takemoto et al. '015).

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claim 1 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 4 of U.S. Patent No. 6,627,015. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 4 of U.S. Patent No. 6,627,015 fully encompasses and discloses all the limitations of claim 1 of the instant Application.

Response to Arguments

9. Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

Applicants argue, "Applicants respectfully submit that the objection to the specification is rendered moot by the present amendment to Claim 1. Claim 1 has been amended to no longer recite the term "free state" and support for the amendment to Claim 1 has been provided above. Accordingly, the objection to the specification is believed to have been overcome."

Claim 1 requires "curing said first adhesive and said second adhesive such that said intermediate member, but not said first and second members, can move due to shrinkage of at least one of said first adhesive and said second adhesive". The specification does not expressly disclose that during curing of the adhesives the intermediate member, but not said first and second members, can move due to shrinkage of at least one of the adhesives. Applicants have

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shown support for releasing the intermediate members prior to curing the adhesives while the first and second members remain chucked, and applicants original claim 1 discloses that the intermediate member can move due to shrinkage of at least one of the adhesives during cure such that a 35 USC 112 first paragraph rejection is not being made. However, there is no disclosure in the specification of at least one of the adhesives shrinking during cure, and there is no disclosure in the specification of the intermediate member and not the first and second members moving due to the shrinkage.

Applicants further argue, "However, Applicants respectfully submit that the '015 and '784 patents fail to disclose the steps of curing the first adhesive and the second adhesive such that the intermediate member, but not the first and second members, can move due to shrinkage of at least one of the first adhesive and the second adhesive, as recited in Claim 1."

The new limitation is addressed in the rejections above.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

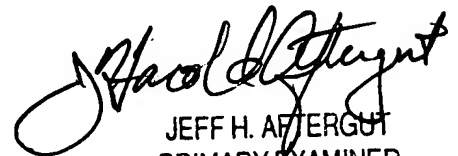
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **John L. Goff** whose telephone number is **(571) 272-1216**. The examiner can normally be reached on M-F (7:15 AM - 3:45 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571) 272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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